

REMARKS

Reconsideration of the application is requested.

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Claims 1-20 remain in the application. Claims 10-12 have been amended.

The specification has been amended to delete a sentence appearing in error, as it merely stated instructions to the typist. Claims 10-12 have been corrected as required by replacing the reference to formulas 5-34 as defined above (i.e. in claim 1) by a copy of each formula.

No new matter is introduced by these amendments.

35 U.S.C. § 112

Claims 10-12 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to define the formula 5-34 within the claim. The claims have been amended to include a copy of each formula within the claim.

35 U.S.C. § 102

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Claims 1-20 have been rejected under 35 U.S.C. § 102(a) as being anticipated by EP 905170 or 905169 "in the abstract and at pages 3-5 of each reference where the diamine compounds meet the claimed scope for claims 1-20."

It is respectfully submitted that the rejection is in error, as the claimed scope of claims 1-20 and the cited passages of the references (and in fact the entire disclosure of each reference) are mutually exclusive.

The present claims are limited to compounds comprising partial structures 3 and 4 shown in the third line of claim 1 in which the member T is defined as a residue selected from the group consisting of the residues represented by formulas 5-34 in which each member for which more than one assignment is possible (i.e. A8 to A21, X, M, and Q) are clearly defined.

The rejection has cited the abstract (i.e. item 57 on the first page) and the diamine compounds at pages 3-5 of each EP document as meeting the claimed scope of the present claims. The rejection appears to be based on a perceived similarity between the member Z in the first formula on page 3 of each reference (and in the abstract) with the member T in the present claims. Careful examination of the possible assignments of Z in each reference and T in the present claims, however, shows that these members, and hence the compounds in which they are present, are distinct.

In the abstract, Z is defined as "ein aromatischer oder heterocyclischer Rest" which translates to "an aromatic or heterocyclic residue." The art of organic chemistry knows many

thousands of aromatic residues and many thousands of heterocyclic residues. Accordingly, one skilled in the art looks beyond the abstract to the body of the document for an enabling disclosure.

When that is done, it can be seen at a glance that T of the present claims differs from all the thirteen possible assignments of Z shown on page 3 of each reference. Evaluation of the twelve possible assignments of Z shown on page 4 of each reference requires consideration of the possible assignments of the member M.

The first assignment of M disclosed at page 4, line 42 of each EP document "eine Einfachbindung" translates to "a single bond." The remaining twenty assignments of M disclosed at page 4, lines 42-44 and the ten assignments of M disclosed at page 5 of each reference are chemical formulas not requiring translation. None of these assignments is within the scope of the present claims.

The present claims include compounds of formula 3 or 4 in the third line of claim 1 in which the member T is assigned as in formulas 8 or 9, wherein M is selected from the group consisting of residues represented by formulas 10-14 shown on the fourth line of page 38 and residues represented by formulas 15-34 shown on the bottom of page 38 and the top of

page 39. It can be seen that none of the claimed assignments of M is disclosed in either of the EP documents.

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Consequently, it is respectfully submitted that nothing in the claimed scope of claims 1-20 is disclosed in either EP 905169 or EP 905170.

In this connection the Examiner's attention is respectfully directed to the decision by the Court of Appeals for the Federal Circuit in the case of Akzo NV v. US International Trade Commission, 1 USPQ2d 1241 (Fed.Cir. 1987). The Court upheld the patentability of a claim to a process of extruding a spinning dope comprising a polyamide and a solvent of sulfuric acid of at least 98% concentration over a reference that called for the use of sulfuric acid but did not call for the use of at least 98% concentrated sulfuric acid. The court also reiterated the legal standard of anticipation, stating (at page 1245).

Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference. W. L. Gore & Associates, Inc. v. Garlock, Inc. 220 USPQ 303, 313 (Fed. Cir. 1983). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. In re Brown 141 USPQ 245, 249 (CCPA 1964).

If the rejection were to rely on the Abstract isolated from the remainder of the reference as disclosing a genus embracing

) the present claims, that would be contrary to the Akzo holding that "prior art references before the tribunal must be read as a whole" (at page 1246) and would not constitute an enabling disclosure of the claims. Correctly read in conjunction with the entire document it is seen not to anticipate the present claims under 35 U.S.C. § 102.

It should also be noted that polybenzoxazoles derived from the compounds of the present invention provide a novel benefit of resistance to diffusion of metals through the dielectric at elevated temperatures, see specification at page 3, line 24 to page 4, line 6, page 4, lines 23-25, page 7, lines 23-26, and the Examples 3 and 5-7.

The cited references disclose nothing related to diffusion of metals or resistance to such diffusion. Thus the present invention is both novel and unobvious in providing beneficial properties not expected from the prior art.

In view of the explanation provided above, claims 1-9 and 13-20 as filed, and claims 10-12 as amended define patentable

subject matter and meet all requirements for prompt allowance,  
which is respectfully solicited.

Respectfully submitted,



For Applicants

WERNER H. STEMER  
REG. NO. 34,956

OSK/WHS/tk

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Lerner and Greenberg, P.A.  
P.O. Box 2480  
Hollywood, Florida 33022-2480  
Tel.: (954) 925-1100  
Fax: (954) 925-1101